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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/976,671 | 10/12/2001 | Toshiyuki Miyabashi | U 013667-3 | 1087 |
| 140 | 7590 | 04/11/2006 | EXAMINER | |
| LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023 | | | SHOSHO, CALLIE E | |
| | | | ART UNIT | PAPER NUMBER |

1714

DATE MAILED: 04/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/976,671

Applicant(s)

MIYABASHI ET AL.

Examiner

Callie E. Shosho

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 8-20, 22 and 25-35.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicants' arguments filed 3/24/06 and 1.132 declaration(s) filed 3/24/06 and 3/31/06 have been fully considered but they are not persuasive. It is noted that the declarations filed on 3/24/06 and 3/31/06 are identical with the exception that the later filed declaration has the original ink signature.

Specifically, applicants argue that Ota et al. (U.S. 2002/0075369) is not a proper reference against the present claims under 35 USC 102(e) given that there is no disclosure in Ota et al. of combination of components as presently claimed. Applicants argue that while Ota et al. disclose vast number of individual components, there is no suggestion in Ota et al. to select out the recited components from among them in order to produce the claimed combination.

The present claims require, in addition to pigment, polymer emulsion, water, and organic solvent which is clearly disclosed by Ota et al., a combination of solid wetting agent that is selected from the group consisting of hyaluronic acid, trimethylolpropane, and 1,2,6-hexanetriol and penetrating comprising 1,2-hexanediol or 1,2-pentanediol.

It is noted that paragraph 89 of Ota et al. discloses the use of wetting agent utilized in the preparation of the pigment dispersion (which becomes part of the ink). While it is agreed, as argued by applicants, that paragraph 89 of Ota et al. states that any wetting agent can be used without restriction, the fact remains that Ota et al. explicitly disclose the use of 1,2,6-hexanetriol as presently claimed.

Further, paragraph 197 discloses the use of 1,2-hexanediol in the ink wherein the choice of 1,2-hexanediol is from amongst a small group, i.e. 11, not from amongst a vast number of choices.

Thus, given that Ota et al. discloses the use of 1,2,6-hexanetriol (as part of pigment dispersion) and disclose the use of 1,2-hexanediol, Ota et al. clearly disclose the use of both 1,2,6-hexanetriol and 1,2-hexanediol as presently claimed. While the choice of 1,2,6-hexanetriol is from large list of wetting agents, applicant's attention is drawn to MPEP 2131.02 (A) which states that "...when the species is clearly named, the species claim is anticipated no matter how many other species are additionally named". *Ex Parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). Further, the choice of 1,2-hexanediol is not from amongst vast number of choices but from small group.

Applicants argue, and the examiner agrees, that there are no examples in Ota et al. that disclose the claimed combination of ingredients. However, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others", *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). A fair reading of the reference as a whole as discussed above discloses ink as presently claimed.

With respect to the 35 USC 103 rejections of record set forth in paragraphs 5-8 of the office action mailed 11/18/05, applicants point to the 1.132 declaration filed 3/24/06 and 3/31/06 which compares ink within the scope of the present claims, i.e. comprising 1,2-hexanediol and trimethylolpropane, with ink outside the scope of the present claims, i.e. comprising no 1,2-

hexanediol (Ink I) or comprising no trimethylolpropane (Ink II). It is shown that the ink of the present invention is superior in terms of anti-clogging property, ejection stability, print quality, storage stability, and/or fast drying property.

Firstly, it is noted that the first page of each of the declarations states that the Serial Number of the present application is 09/255,323, which is incorrect.

Further, the declaration is not persuasive given that paragraph 2(3) of the declaration discloses that the table set forth on page 2 of the declaration includes the inventive ink that corresponds to example B3 of the present specification. However, the table states "Example B2". Thus, it is not clear what inventive ink is being compared to comparative Ink I and Ink II.

Clarification is requested.

It is noted that if the inventive ink is actually that of example B2 (table in declaration is correct), then the declaration would not be successful in establishing unexpected or surprising results over the cited prior art given that there would not be proper side-by-side comparison between ink within the scope of the present claims (Example B2) and ink outside the scope of the present claims (comparative Ink I and Ink II). That is, there is not proper side-by-side comparison between ink of example B2 and comparative inks given that the inks contain different types and amounts of polymer fine particles, solvent, and pigment as well as different type of solid wetting agent. Thus, it would not be clear if the differences between the inventive ink and comparative inks were due to the solid wetting agent or the penetrating agent or to the different pigment, polymer, solvent, etc. utilized in the inks.

However, it is noted that if the inventive ink is actually that of example B3 (table in declaration is incorrect), then the declaration would be successful in establishing unexpected or

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surprising results over the cited prior art and would successfully overcome all the 35 USC 103 rejections of record.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
4/6/06